

REMARKS

I. Introduction

Claims 1, 3-146 are pending in the above-identified application. Claims 19-37, 55-72, 91-109, and 128-146 were withdrawn due to a previous restriction requirement. Claims 1, 38, 73 and 110 are currently amended. Claims 9-18, 39-54, 74-90, and 111-127, are original. Claims 3-8 and 14 were previously presented. No new matter is added.

II. Summary of the Office Action

Claims 1-3, 7-9, 14-17, 38, 39, 43-45, 50-53, 73-75, 79-81, 86-89, 110-112, 116-118 and 123-126 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,618,746 to Desai et al. (hereinafter, "Desai"). Claims 4-6, 40-42, 76-78 and 113-115 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai. Claims 10, 11, 46, 47, 82, 83, 119 and 120 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of U.S. Patent No. 6,895,405 to Choi et al. (hereinafter, "Choi"). Claims 12, 18, 48, 54, 84, 90, 121 and 127 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of U.S. Patent No. 6,993,495 to Smith et al. (hereinafter, "Smith"). Claims 13, 49, 85 and 122 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of Choi and further in view of Smith.

Applicants respectfully traverse the Examiner's objections and rejections.

II. Summary of the Telephonic Interview with Examiner Robertson

Applicants' representatives James A. Leiz and Vasanth Sarathy thank Examiner Robertson for the courtesies extended during the telephonic interview on June 19, 2009. During the interview, Applicant's representatives first gave Examiner Robertson a broad overview of the differences between Desai and the claimed invention. Applicants' representatives also contended, more specifically, that Desai did not disclose, among other things, the claim limitation of "inclusion value." No agreement was reached. Applicants' representatives proposed amending the claims to more particularly recite, among other things, that the inclusion value is determined dynamically. Examiner Robertson welcomed the proposed amendment, but the Examiner nevertheless required Applicants' representatives to put their amendments in writing for his consideration.

V. Response to the Rejections of Claims 1-18, 38-54, 73-90 and 110-127

Claims 1-3, 7-9, 14-17, 38, 39, 43-45, 50-53, 73-75, 79-81, 86-89, 110-112, 116-118 and 123-126 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,618,746 to Desai. As stated in the MPEP §2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Generally, amended independent claim 1 is directed to a method for selecting survey questions for inclusion in a survey. The method includes storing survey questions and survey response information provided by survey participants and determining dynamically during the survey a single inclusion value for each survey question. The method includes selecting a stored survey question for inclusion in a survey based on the inclusion value of each survey question and providing the selected survey question to a survey participant. The inclusion value is based on at least two of associated conditional branching logic, response variance for each stored survey question, and a global inclusion value multiplier.

As noted in our previous response, Desai fails to disclose an inclusion value. Desai further fails to disclose steps for determining, dynamically during the survey, a single inclusion value and selecting questions based on the inclusion value. The Office Action states that Desai teaches this limitation and that the "inclusion value is the determination, yes or no, inherent to the 'branching' or 'piping' logic of Desai." Applicants respectfully disagree. Although Applicants disclose that the inclusion value may be based on associated conditional branching logic, the inclusion value itself is not inherent in conditional branching. Conditional branching, as described in Desai, is merely a user-driven selection whereby based on a user response of "yes" or "no" a question in a survey is presented to the user. These yes/no responses are simply user responses and not inclusion values. If the user selects "yes", then the user is presented with a specific predetermined question; if the user selects "no", then the user is presented with another specific predetermined question. There is no dynamic determination of a single inclusion value for a question.

There is also nothing in Desai for selecting a question based on the inclusion value. The Office Action argues that in Desai, "the inclusion value of the selected question is '1' [and] the inclusion value of the other unselected question

is '0'." This is not disclosed anywhere in Desai. Moreover, Desai's conditional branching does not require assigning "ones" and "zeros" to user-responses.

In view of the foregoing, Desai fails to disclose an inclusion value and steps for determining, dynamically during the survey, a single inclusion value and selecting questions based on the inclusion value. Thus, Desai does not disclose all the elements of amended independent claim 1 and original dependent claims 15 and 16 as is required by MPEP §2131 to make a proper rejection under §102. Therefore, Applicants request reconsideration and withdrawal of the 35 U.S.C. §102 rejections of independent claim 1 and dependent claims 15 and 16. Claims 3, 7-8, 14, and 17 depend from claim 1 and add further limitations thereto. Therefore, Applicants request reconsideration and withdrawal of the 35 U.S.C. §102(e) rejections of these claims, as well.

Independent claims 38, 73 and 110 include similar subject matter. Applicants respectfully requests reconsideration and withdrawal of the § 102 rejections of independent claims 38, 73 and 110. Claims 39, 43-44, 50-53, 74-75, 79-80, 86-89, 111-112, 116-117 and 123-126 depend from claims 38, 73 or 110 and add further limitations thereto. Thus, Applicants request reconsideration and withdrawal of the rejections of these claims, as well.

Claims 4-6, 40-42, 76-78 and 113-115 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai. Claims 18, 54, 90 and 127 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of U.S. Patent No. 6,993,495 to Smith. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). As noted above, Desai fails to teach or suggest several limitations in independent claims 1, 38, 73 and 110. For example, there is no teaching or suggestion in either reference for determining, dynamically, a single inclusion value for each survey question. Thus, Applicants request reconsideration and withdrawal of the rejections of these claims, as well.

Claims 10, 11, 46, 47, 82, 83, 119 and 120 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of U.S. Patent No. 6,895,405 to Choi. Claims 12, 48, 84, and 121 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of U.S. Patent No. 6,993,495 to Smith. Claims 13, 49, 85 and 122 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of Choi and further in view of Smith. Applicants have canceled these dependent claims without prejudice and have included some of the subject matter of these dependent claims into their

corresponding independent claims 1, 38, 73 or 110. Accordingly, Applicants' above arguments identifying deficiencies in Desai and Smith apply to these dependent claims, as well.

Furthermore, Choi fails to fill these gaps in Desai and Smith. Therefore, even combining the teachings of Desai, Smith, and Choi there is no teaching or suggestion for determining, dynamically, a single inclusion value for each survey question.

Since neither Desai nor Smith nor Choi teach or suggest each and every element of independent claims 1, 38, 73 and 110, Applicants respectfully submit that the cited references do not render obvious Applicants' independent claims 1, 38, 73 and 110. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 4-6 and 18 depend from claim 1 and add further limitations thereto. Thus, Applicants request reconsideration and withdrawal of the rejections of these claims, as well. Claims 40-42, 54, 76-78, 90, 112-115, and 127 depend from claims 38, 73 and 110, respectively, and add further limitations thereto. Thus, Applicants request reconsideration and withdrawal of the rejections of these claims, as well.

VI. Conclusion

In view of the foregoing, the claims are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Applicants believe that we have appropriately provided for the fees due in connection with this response. However, if a fee is due, please charge our Deposit Account No. 06-1075, under Order No. 002278-0004 from which the undersigned is authorized to draw.

Respectfully submitted,

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